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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/509,237	03/20/2000	Seth D. Rose	344-P-16-USA	9691

7590

04/19/2006

Indiano Vaughan LLP
One North Pennsylvania Street
Suite 850
Indianapolis, IN 46204

EXAMINER

FUBARA, BLESSING M

ART UNIT	PAPER NUMBER
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1618

DATE MAILED: 04/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/509,237

Applicant(s)

ROSE ET AL.

Examiner

Blessing M. Fubara

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Examiner acknowledges receipt of change of power of attorney, amendment and remarks filed 1/12/06. Claim 9 is pending.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

2. Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The issue raised in the previous office has been addressed. However, it is unclear if the “modifying the water solubility of the polymer ... by attaching the hydrophobic group of the compound containing the hydrophobic group to the water soluble polymer to produce a water insoluble interaction product” is a step and not part of the liquid composition.

The above phrase is interpreted as a method step for purposes of examining the claim. Clarification is respectfully requested.

It is also not immediately clear what the compound containing the hydrophobic group may be from the specification that applicants consider as their invention. If a particular disclosure of that compound is present in the as filed specification, then, a recitation of the compound or the compounds in a Markush group, if more than 1 may help to expedite the prosecution of the claimed invention.

Furthermore, a search for polyiminodiacetamide returned zero hit. Clarification is respectfully requested to determine if this is a new compound or it is a misspelled word.

Claim Rejections - 35 USC § 103

3. The rejection of claim 9 under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Katada et al. (US 5,080,889) is withdrawn because the step where the water soluble polymer and the compound containing the hydrophobic group are interacted to modify the water soluble polymer is not disclosed in the Katada prior art. Since that phrase is taken as part of a positive method step of the claims, then applicants' argument is persuasive.

4. The rejection of claim 9 under 35 U.S.C. 103(a) as being unpatentable over Mueller et al. (US 4,826,677) is withdrawn because the step where the water soluble polymer and the compound containing the hydrophobic group are interacted to modify the water soluble polymer is not disclosed in the Mueller prior art. Since that phrase is taken as part of a positive method step of the claims, then applicants' argument is persuasive.

5. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over applicants' admitted prior art in view of Alwattari et al. (US5,874,072) or Rechelbacher et al. (US 5,849,280).

Applicants in the specification at page 8, lines 8-19, admit of a composition comprising hydrophobe modified hydroxypropyl cellulose water soluble polymer, ethanol that polymerizes in-situ upon application to body tissue.

However, the claim requires either carboxymethylcellulose or hydroxyethylcellulose. Alwattari discloses that hydroxypropylcellulose and hydroxyethylcellulose are equivalent as film forming polymers (column 3, lines 56-63); similarly, Rechelbacher discloses that hydroxypropylcellulose and hydroxyethylcellulose are equivalent as film forming polymers

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(claim 37). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use hydroxypropylcellulose modified by a compound containing hydrophobic group as the film-forming polymer. It would have been obvious to substitute the hydroxyethylcellulose polymer of Alwattari or Rechelbacher for the hydroxypropylcellulose in view of the fact that Alwattari or Rechelbacher teach hydroxypropylcellulose and hydroxyethylcellulose as equivalent film forming polymers and with the expectation that the composition will form a film upon application of the composition to a body tissue.

6. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pomerantz (US 5,081,158) in view of Alwattari et al. (US5,874,072) or Rechelbacher et al. (US 5,849,280).

Pomerantz discloses applies a composition comprising modified hydroxypropylcellulose, topical anesthetics, ethanol to body tissue and the composition forms a film on the body tissue (abstract; columns 1-4; Example 1-4 and claims 1-5).

However, the claim requires either carboxymethylcellulose or hydroxyethylcellulose. Alwattari discloses that hydroxypropylcellulose and hydroxyethylcellulose are equivalent as film forming polymers (column 3, lines 56-63); similarly, Rechelbacher discloses that hydroxypropylcellulose and hydroxyethylcellulose are equivalent as film forming polymers (claim 37). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use hydroxypropylcellulose modified by a compound containing hydrophobic group as the film-forming polymer. It would have been obvious to substitute the hydroxyethylcellulose polymer of Alwattari or Rechelbacher for the hydroxypropylcellulose of Pomerantz in view of the fact that Alwattari and Rechelbacher teach hydroxypropylcellulose and

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hydroxyethylcellulose as equivalent film forming polymers and with the expectation that the composition will form a film upon application of the composition to a body tissue.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Blessing M. Fubara whose telephone number is (571) 272-0594.

The examiner can normally be reached on 7 a.m. to 5:30 p.m. (Monday to Thursday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Hartley can be reached on (571) 272-0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Blessing Fubara
Patent Examiner
Tech. Center 1600

A handwritten signature in black ink, appearing to read "MB Fubara", is written over the printed name "Blessing Fubara".